

## REMARKS

### Status of Claims

Claims 1 – 6 and 8 – 20 stand rejected at the present time. Of these claims, Claim 1, 11 and 17 are independent claims. Claims 2-6 and 8-10 depend upon Claim 1, claims 12-16 depend upon Claim 11 and claims 18-20 depend upon Claim 17.

### Rejections Pursuant to 35 USC § 102

The Office rejects claims 1-6 and 10-20 as being anticipated by U.S. Patent No. 5,469,839 to Kasulis et al. (the “Kasulis patent”).

“Under 35 U.S.C. 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997) (emphasis added). In this regard, the Kasulis patent is not an anticipatory reference to the claims for several reasons.

For example, Claims 1, 11 and 17 all recite that the viewable surface has an “angle of incidence and an angle of reflection which are both substantially equal as viewed by a view of the system”. In contrast, the Kasulis patent discloses a viewable surface 76 which has a separate and different angular surface plane than viewable surface 78 (*see* the Kasulis patent, Figure 8, where surface 78 is at approximately a 45 degree angle to surface 76). Indeed, the Kasulis expressly teaches away from the present invention, as it requires viewable surfaces which have “an orientation offset from the vertical within a fireplace” (*see* Abstract), so that the rear surface has a different angular position than the surface 78 (*see* Kasulis patent, Col. 5, *l.* 66 – Col. 6, *l.* 3). This is a very specific orientation which is contrary to the teachings of the present invention. Because of this very specific orientation, the Kasulis patent can never achieve an “angle of incidence and an angle of reflection which are both substantially equal as viewed by a view of the system”. Moreover, the upper angled mirror “is set an at angle that reflects heat” (*see* Col. 7, *l.* 15-17), which is an entirely different purpose than that of the present invention.

The Office also asks the Applicant to examine the Kasulis patent, stating that the:

“image of the flames (at 78) are located within the vertical surfaces (76, 78, 86) and presented by the reflective material to a view at least in a location oriented according to the perspective represented in figure 8[.]”

The Office’s analysis is incorrect. Figure 8 clearly shows that surface 78 is not a vertical surface, and if it is a “vertical surface”, it is not vertical to the same surface plane of surfaces 76, 86. The Kasulis patent expressly teaches that the surface 78 is “angled” (*see* Col. 6, *l.* 2, and Figure 8). As such, surface 78 can never have an “angle of incidence and an angle of reflection which are both substantially equal as viewed by a view of the system” as surfaces 76, 86. The Office concludes that the reflective panel “would *necessarily and inherently* have an angle of incidence and an angle of reflection with are both substantially equal as viewed by a viewer of the systems in the manner set forth in applicant’s claims.” While the Office recites a portion of the Applicant’s specification, the cited portion specifically identifies that “in accordance with one embodiment of the present invention, the light or image reflective material is placed within the vertical surfaces A, B, C of a firebox” – there is nothing in the specification that recites an angled surface to the vertical surfaces in a firebox.

While the Office’s analysis is factually incorrect, the Kasulis patent would also not function according to the claims presented. For example, in direct contrast to the Office’s reasoning, any images reflecting off

the Kasulis patent surface 76 would necessarily result in an image that distorts or blurs the images reflecting onto and from the vertical surfaces 76, 86 to a viewer of the Kasulis invention. In other words, the Kasulis patent fails to appreciate the angle of incidence and angle of reflectance properties as recited in the present invention. While the Office states that the result “would *necessarily and inherently* have an angle of incidence and an angle of reflection with are both substantially equal”, the Office fails to provide any evidence on this issue. In accordance with MPEP § 2112, the Applicant asks the Office to support this analysis if a continued rejection on this basis is made. The Applicant submits that the Office cannot support this analysis because any reflection from the Kalulis patent surface 76 onto either surface 78 or 86 would result in a blurred, distorted or multiple imaging to a view of the system.

Moreover, the rejected claims recite that the invention is “measured to substantially fit within, and couple to, one or more interior surfaces of the fireplace.” There is absolutely no disclosure in the Kasulis patent that its surfaces “substantially fit” within the interior firebox because the Kasulis disclosure is expressly intended to have one of the major surfaces 68/78 be angled away from an interior surface of the firebox, and supported by brackets through a hinge, so that its angular position can be changed through a series of dials 44 (*see* Col. 5, ll. 51-57) for heat reflection (*see* Col. 7, l. 15-17). As such, the Kasulis patent expressly teaches away from the present invention.

Moreover, the Office cites Col. 5, l. 58 – Col. 6, l. 8, to apparently emphasize that the Kasulis patent has “interior side surfaces of the fireplace as well as the apertures 82 in the edges of the back and angled reflector plates” to couple to the interior surfaces of the fireplace. However, this recitation only discusses how side surfaces 86 couple to the interior of the fireplace, and does not disclose that surfaces 76 and 78 are substantially coupled to the interior firebox. In fact, there is no disclosure at all of how surfaces 76 and 78 (as the Kasulis embodiment illustrated in Figures 8 and 9 relied on by the Office) are coupled to the interior surfaces of the firebox.

For each of the foregoing reasons, the Kasulis patent fails to anticipate the rejected independent claims (i.e., Claims 1, 11 and 17), and those claims which depend on these claims (*i.e.*, claims 2-6, 8-10, 12-16 and 18-20).

Finally, the Office also states that the claims’ phrase “measured to substantially fit within, and couple to, one or more interior surfaces of the fireplace” is a recitation of intended use, and fails to impart a structural limitation to distinguish the claimed invention over the art of record. This statement is made in reference to the Section 102 rejection, and no other statutory rejection. Initially, Section 102 does not require any recitation of a structural limitation. As such, the Applicant finds it difficult to respond to the Office’s statement. Nevertheless, as illustrated above, the claims, as recited, already recite an invention that is distinguishable apart from the prior art. And, as long as those of ordinary skill in the art realize that the dimensions could easily be obtained for a firebox, the patent law does not require “that all possible lengths corresponding to the” dimensions found in all fireboxes made be listed in the specification, “let alone, they be listed in the claims.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986). Considering that the present invention concerns basic fireplaces which have existed for many, many years, the Applicant submits that those of skill in the art would understand the phrase “measured to substantially fit within, and couple to, one or more interior surfaces of the fireplace” as it applies to this invention, which is a functional limitation relative to the varying measurements found inside a firebox.

Reconsideration is respectfully requested.

#### **Rejections Pursuant to 35 USC § 103**

The Office rejects claims 8 and 9 as being unpatentable over the Kasulis patent in view of Japan disclosure

2003-79507 (the "Japan disclosure").

In traversal, it follows that since Claim 8 is dependant upon Claim 3, Claim 3 is dependant upon Claim 1, and because the Office has not rejected Claim 1 under Section 103, then Claim 8 cannot be rejected under Section 103. Also, since Claim 9 is dependant upon Claim 3, Claim 3 is dependant upon Claim 1, and Claim 1 is not rejected under Section 103, then Claim 9 must similarly stand as not rejected under Section 103. As such, the Applicant cannot respond to the Office's Section 103 prior art reasoning and rejections because Claims 8 and 9 must stand as not being rejected, since they are dependant upon a non-rejected claim (Claim 1) pursuant to Section 103.

Reconsideration is respectfully requested.

**Conclusion**

In light of the foregoing amendments and remarks, the Applicant respectfully requests the Office to withdraw the pending objections and rejections, and allow the present application to issue. The undersigned would welcome a phone call from the Office to expedite the resolution of this application. A return postcard is attached, which the Applicant requests the Office to stamp and mail to the Applicant.

Respectfully submitted,

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